

REMARKS

On January 30, 2004, Applicants' attorney and the Examiner conducted a telephone interview to discuss several claims. Claim 4 is exemplary. Claim 4 recites "a sound generating device or light source coupled to said RFID." The gist of the Examiner's position was that the term "coupled" was interpreted extremely broadly, and encompassed apparatus in which the sound generating device or light source was not attached or mechanically connected in any way to the RFID. (Applicants' attorney understands that the Examiner did not interpret "coupled" as requiring that the light source or sound generating device be proximate to the RFID.) The Examiner suggested that the claim language be amended to more clearly describe the claimed subject matter.

Claim 3 is exemplary of other subject matter discussed during the telephone interview. The Examiner alleged that one of the references discussed a light beam pointing toward a tag. (An exact citation was not mentioned during the interview.) Based on the Examiner's remarks, Applicants' attorney understands that the Examiner opined that claim 3 was broad enough to cover some sort of bar code scanner in which a person points a light beam toward a bar code. Again, it was suggested that language of claim 3 be clarified.

Claims 19-21 are exemplary of other subject matter discussed during the interview. Applicants' attorney argued that the cited art has absolutely nothing to do with the claimed subject matter. The Examiner indicated that he would consider this matter upon receiving a response to the Office Action.

The Office Action states: "Claims 30-60 are objected to because ... there are two (2) distinct claims numbered 30. For the purpose of this examination, the second claim

will be referred to as claim 31, and all numbers of all subsequent claims will be incremented by one (i.e. there are now 61 claims pending). Appropriate correction is required when submitting a Response to this Action.” Office Action, page 2. The claims set forth in this response correct this numbering error.

The Office Action includes a restriction requirement. Applicants elected to prosecute claims 1-32 and 60-61. The Office Actions states that “Affirmation of this election must be made by Applicant in replying to this Office Action.” Office Action, page 3. Applicants affirm this election.

The Office Action rejects claims 1-31 and 60-61 “as being unpatentable over Belcher et al. in view of Garber et al....” Office Action, page 4. Applicants have moved the limitation of claim 4 into claim 1 to thereby overcome this rejection as applied to claim 1. In particular, claim 1 now recites:

a sound generating device or a light source secured to said queried signal responsive tag identifying a package corresponding to said queried signal responsive tag.

The Office Action concedes that Belcher does not disclose the above-quoted limitation, but argues that Belcher in view of Garber renders obvious “means for identifying comprising a sound 17 generating device or a light source coupled to said RFID 18.” Office Action, page 6. Applicants do not believe that reference numbers 17 or 18 are used in either Belcher or Garber. Further, neither Belcher nor Garber teach a sound or light-generating device secured to a queried tag. Therefore, no combination of these references could possibly render obvious claim 1. Claims 6 and 7 similarly distinguish over Belcher.

The Office Actions concedes that Belcher does not disclose “an output structure coupled to said tag for providing an audible or visible output identifying the package corresponding to said queried tag [claims 6, 8, 10]”. Office Action, pages 4-5. However, the Office Action alleges that “Garber does disclose exactly a reading device with light and audio feedback features (Fig 13; C14, L53-C15, L10; ‘feedback systems’).” Office Action, page 5. The disclosure cited in Garber has nothing to do with Applicants’ invention, and even if one were to combine Garber and Belcher that still would not result in Applicants’ invention. Applicants claim an “output structure **secured** to said tag....” (Claim 6; similar subject matter recited in claims 1 and 7). As can be seen in Garber Fig. 13 and 14, his output structure is not secured to his tag. Therefore, Belcher combined with Garber fails to teach or suggest Applicants’ invention.

Claim 3 has been rewritten in independent form. Claim 3 recites: “at least one light beam source for pointing to said package with a light beam, the direction of said light beam being in response to said signal.” Again, the Office Action concedes that this limitation is not present in Belcher. Although the Office Action implies that this limitation is taught in Garber (Office Action, page 6), in point of fact, it is not taught in Garber. Therefore, claim 3 should be allowed.

Claim 5 recites: “a pointing device for identifying a package corresponding to said queried tag by pointing toward said package in a direction responsive to said signal generated by said tag.” Neither Belcher nor Garber teach or suggest this limitation.

Claim 6 recites: “an output structure secured to said tag for providing an audible or visible output identifying the package corresponding to said queried tag.” Neither Belcher nor Garber teach or suggest this limitation.

Claim 7 recites:

the tag is an RFID and the output structure is either a light emitting device secured to the queried RFID for providing a visible output identifying said RFID or a sound emitting device secured to the queried RFID for providing an audible output identifying said RFID.

Applicant respectfully submits that this limitation cannot be found in either reference.

The Office Action rejects claim 8, alleging that Belcher teaches “determining the location of the tag in response to the reply signal from the tag and indicating the location of the tag....” Office Action, page 4. Applicants have amended claim 8 to distinguish over Belcher. In particular, claim 8 now recites: “determining the location of the tag in response to the reply signal and indicating the location of the tag using one or more light beams for pointing toward the tag, the direction of said light beam being responsive to said reply signal.” The cited art neither teaches nor suggests this limitation.

The Office Action alleges that claim 10 is obvious in light of Belcher. Applicants have amended claim 10 to distinguish over Belcher. Specifically, claim 10 recites:

providing an audible and/or visible indication at the location of the tag in response to said querying of said tag, said audible and/or visible indication being provided by an indication source **secured** to said tag.

The cited art neither teaches nor suggests the above-quoted limitation.

Regarding claim 13, the Office Action states:

Belcher does not specifically disclose means for generating a list of transactions at said destination when said vehicle is determined to have arrived at said destination [claims 13, 14, 19].

However, Belcher teaches that his RF locating system may be used in many different applications (C12, L30-L59). One such obvious application to one ordinarily skilled in the art at the time the invention was made would be to further automate shipping, delivering, picking up, and taking possession of goods, in order to fully utilize the capabilities of the system.

Office Action, page 5. Applicants traverse this rejection. A claim cannot be obvious unless each of the claim limitations is suggested in the prior art. MPEP § 2143.03. Neither Belcher nor Garber teaches the means for generating (nor does the Office Action allege otherwise).

Second, the prior art must suggest the desirability of the claimed invention. MPEP § 2143.01. Neither Belcher nor Garber provides any reason why the modification suggested by the Examiner is desirable. Thus, again, claim 13 is patentable over the cited references.

Third, Belcher is directed to the problem of tracking objects in “a prescribed asset management environment 12....” Col. 4, lines 30-31. See Fig. 1 and also Col. 2, lines 18-31. Thus, Belcher pertains to an environment such as a factory or warehouse where one seeks to track various objects. The idea of “generating a list of transactions at said destination when said vehicle is determined to arrive at said destination” is alien to Belcher’s purposes. Thus, again, claim 13 distinguishes over the cited art. Claims 14-19 are patentable for at least the reasons set forth above regarding claim 13.

Claim 16 recites: “Method of claim 14 wherein a GPS is affixed to the vehicle, said automatically sensing being performed by said GPS.” The Office action concedes that “[b]oth references are silent on a GPS being affixed to the vehicle, said automatically sensing being performed by said GPS.” Office Action, page 7. However, the Office Action argues that

because GPS has become a well-known popular, and cost effective method for accurate determination of a geographical location, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have integrated this feature into Belcher’s accurate, and fast, thus attracting even more users to the system.

Office Action, page 7. This is incorrect. The entire idea behind Belcher is to provide inexpensive tags that can be affixed to individual packages within a factory. Belcher has a specific notion of what type of device should be used. Thus, Belcher states:

it should be observed that the invention resides primarily in what is effectively a prescribed arrangement of conventional communication circuits and associated digital signal processing components and attendant supervisory control circuitry therefor, that controls the operations of such circuits.

Belcher col. 4, lines 8-14. MPEP §2143.02 states that a “proposed modification cannot change the principle of operation of a reference.” The Office Action seeks to replace Belcher’s invention with something that operates in a manner completely different from his invention. This is something that the MPEP forbids. (Claim 24 distinguishes over the cited art for similar reasons.)

Claim 18 recites: “Method of claim 14 wherein said list of transactions comprises a list of packages to be placed on said vehicle from said destination.” The Office action does not provide any reason why this claim is taught or suggested by the prior art. Therefore, the rejection of claim 18 is improper.

Regarding claim 20, the Office Action argues:

Belcher teaches that his RF locating system maybe used in many different applications.... One such obvious application to one ordinarily skilled in the art at the time the invention was made would be to further automate shipping, delivering, picking up, and taking possession of goods, in order to fully utilize the capabilities of the system.

Another obvious application would be advising shippers and receivers alike of the time when goods have moved from or reached certain locations, therefore meeting the further limitations:

automatically communicating a to a purchaser when the goods have arrived at said destination [claims 20, 21, 27}.

Office Action, page 5. Applicants traverse this rejection. Claim 20 recites:

a vehicle for carrying packages;

means for determining when the vehicle reaches a destination; and

means for automatically communicating to a purchaser when the goods have arrived at said destination.

As mentioned above, in order for a claim element to be rendered obvious, each and every limitation of the claim must be suggested in the prior art. MPEP §2143.03. The Office Action essentially concedes that the cited art does not suggest the “means for automatically communicating”. Therefore, the rejection of claim 20 violates this section of the MPEP. Claims 21-27 distinguish over the cited art for at least the same reason as claim 20.

Applicants again point out that the above-mentioned limitations have nothing to do with Belcher’s objective of tracking objects within a specific environment, e.g. a factory or warehouse. Thus, again, the cited art fails to teach or suggest claims 20-27.

Claim 25 recites: “said sensing device being coupled via a WAN to a computer system, said computer system initiating a message to a purchaser in response to the arrival of said system.” The cited art does not teach or suggest a WAN. If the Examiner believes Belcher discloses a WAN, the Examiner is requested to point out exactly where this disclosure exists. Otherwise, claim 25 must be allowed. Claim 26 must be allowed for similar reasons.

Applicants also point out that a WAN is inappropriate for Belcher’s application. Belcher uses several “readers 10” in environment 12 to pinpoint the location of an object of interest. See Col. 10, lines 10-28. These readers must somehow be connected so that the time each reader 10 receives a signal from a tag can be compared to the time other

readers receive a signal from a tag. There is no reason set forth in Belcher to think one would or could use a WAN for this purpose.

The limitations of claim 29 have been moved into claim 28, and claim 29 has been canceled. Claim 29 distinguishes over the cited art for reasons similar to claim 25 discussed above.

As the claims distinguish over the cited art, Applicants earnestly request that they be allowed. If the Examiner's next action is other than allowance, the Examiner is respectfully requested to telephone Applicants' attorney at (408) 732-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "K. Leeds", written over the printed name.

Kenneth E. Leeds
Reg. No. 30,566
Attorney for Applicants